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**Practitioner's Docket No.** ___944-001.038-1___    **PATENT**

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Jose COSTA REQUENA**
Application No.:  10/023,456     **Group No.:** 2154
Filed:  October 30, 2001     **Examiner:** Mohammah SIDDIQI
For:     **Reexamination control No.:**
      SYSTEM AND METHODS FOR
      USING AN APPLICATION LAYER CONTROL PROTOCOL TRANSPORTING SPATIAL . . .

**Mail Stop Appeal Brief—Patents**
**Commissioner for Patents**
**P.O. Box 1450**
**Alexandria, VA 22313-1450**

### TRANSMITTAL OF APPEAL BRIEF
### (PATENT APPLICATION OR EX PARTE REEXAMINATION—
### 37 C.F.R. § 41.37)

*NOTE: The phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) (which provides an adjustment of patent term if there is a delay on the part of the Office to respond within 4 months after an "appeal was taken") means the date on which an appeal brief under § 1.192 (and not a notice of appeal) was filed. Compliance with § 41.37 requires that: 1. the appeal brief fee (§ 41.20(b)(2)) be paid (§ 41.37(a)(2)); and 2. the appeal brief complies with §§ 41.73(c)(i)-(x). See Notice of September 18, 2000, 65 Fed. Reg. 56366, 56385-56387 (Comment 38).*

1.   Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on ___June 27, 2006___.

*NOTE: Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31. 37 CFR 41.(a)(1). The brief is no longer required in triplicate. The former alternative time for filing a brief (within the time allowed for reply to the action from which the appeal was taken)*

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### CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
*(When using Express Mail, the Express Mail label number is mandatory;*
*Express Mail certification is optional.)*

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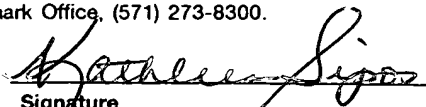
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Date: ___Sept. 18, 2006___

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___Kathleen Sipos___
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* *Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.*

## 2. STATUS OF APPLICANT

This application is on behalf of

    ☒ other than a small entity.

    ☐ a small entity.

        A statement:

        ☐ is attached.

        ☐ was already filed.

## 3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

    ☐ small entity                $250.00

    ☒ other than a small entity     $500.00

**Appeal Brief fee due $ _500.00_**

## 4. EXTENSION OF TERM

*NOTE:*   *37 C.F.R. § 1.704(b) ". . .an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."*

*NOTE:*   *The time periods set forth in 37 C.F.R. § 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 C.F.R. § 1.191(d). See also Notice of November 5, 1985 (1060 O.G. 27).*

*NOTE:*   *As the two-month period set in § 1.192(a) for filing an appeal brief is not subject to the six-month maximum period specified in 35 U.S.C. § 133, the period for filing an appeal brief may be extended up to seven months. 62 Fed. Reg. 53,131, at 53,156; 1203 O.G. 63, at 84 (Oct. 10, 1997).*

☐ The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

*WARNING:*   *The provisions of 37 CFR § 1.136 do not apply in an ex parte reexamination. Any requests for extension must be made pursuant to 37 CFR 1.550(c).*

*(complete (a) or (b), as applicable)*

(a)  ☐  Applicant petitions for an extension of time under 37 C.F.R. § 1.136 (fees: 37 C.F.R. § 1.17(a)(1)-(5)) for the total number of months checked below:

| Extension (months) | Fee for other than small entity | Fee for small entity |
|---|---|---|
| ☐ one month | $ 120.00 | $ 60.00 |
| ☐ two months | $ 450.00 | $ 225.00 |
| ☐ three months | $ 1,020.00 | $ 510.00 |
| ☐ four months | $ 1,590.00 | $ 795.00 |
| ☐ five months | $ 2,160.00 | $1,080.00 |

Fee:   $_____

If an additional extension of time is required, please consider this a petition therefor.

*(check and complete the next item, if applicable)*

☐ An extension for _____ months has already been secured, and the fee paid therefor of $_____ is deducted from the total fee due for the total months of extension now requested.

**Extension fee due with this request $_____**

or

(b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee $ __500.00_____

Extension fee (if any) $ _____

**TOTAL FEE DUE $ _500.00_____**

6. FEE PAYMENT

☒ Attached is a ☒ check ☐ money order in the amount of $_500.00_____

☐ Authorization is hereby made to charge the amount of $_____

   ☐ to Deposit Account No. . _____

   ☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

*WARNING: Credit card information should not be included on this form as it may become public.*

☐ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

☐ A duplicate of this paper is attached.

7. FEE DEFICIENCY

*NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to change the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.*

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AND/OR

☒ If any additional fee for claims is required, charge:

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Date: September 18, 2006

Reg. No.: 58,051

Customer No.: 004955

*Keith P. Obert* (signature)

**SIGNATURE OF PRACTITIONER**

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(Transmittal of Appeal Brief [9-6.1]—page 4 of 5)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

**Jose COSTA REQUENA**

Serial No: **10/023,456**          :          Examiner: **Mohammad SIDDIQI**

Filed: **October 30, 2001**          :          Group Art Unit: **2154**

For: **SYSTEM AND METHODS FOR USING AN APPLICATION LAYER CONTROL PROTOCOL TRANSPORTING SPATIAL LOCATION INFORMATION PERTAINING TO DEVICES CONNECTED TO WIRED AND WIRELESS INTERNET PROTOCOL NETWORKS**

Mail Stop Appeal Briefs-Patents
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P.O. Box 1450
Alexandria, VA 22313-1450

## BRIEF FOR APPELLANT (37 C.F.R. § 41.37)

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Alexandria, VA 22313-1450


## BRIEF FOR APPELLANT (37 C.F.R. § 41.37)

Sir:

This brief is in furtherance of the Notice of Appeal filed in this case on June 27, 2006, which was submitted along with a Pre-Appeal Brief Request for Review. The Notice of Panel Decision from Pre-Appeal Brief Review mailed August 18, 2006 indicated that the application remains under appeal. This is an appeal from the final Office Action mailed December 27, 2005 rejecting claims 17-21.

## I.  REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The real party in interest in this appeal is Nokia Corporation, a corporation organized under the laws of Finland.

## II.  RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c)(1)(ii))

There are no related appeals or interferences.

## III.  STATUS OF CLAIMS (37 C.F.R. § 41.37(c)(1)(iii))

Claims 17-21 are rejected to, claims 1-16 and 22-25 have been withdrawn from consideration.  The rejection of claims 17-21 is being appealed.

## IV.  STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

Applicants submitted a Request for Reconsideration without Amendment on April 27, 2006.  Therefore, applicant did not submit any amendments subsequent to the final Office Action.

## V.  SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

Claim 17 recites a system comprising a central server and a presence server.  The central server is for providing a presence query to the presence server in response to an invitation message from an inviting user to exchange content with an invited user who is registered with the presence server.  See e.g. page 10, lines 6-9.  The presence server is for providing presence information relating to the invited user in response to the presence query.  See e.g. page 10, lines 9-12.  The central server uses the presence information in deciding whether the content of the inviting user is sent to the invited user, stored or refused.  See e.g. page 10, lines 12-15.  The presence query and the invitation message may be communicated according to an application layer control protocol.  See e.g. page 10, lines 29-31.  The presence information relating to presence may pertain to a spatial location of the invited user registered at the presence server.  See e.g. page 11, lines 19-25.

## VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

Claims 17, 18 and 21 are rejected under 35 U.S.C. §102(e) as anticipated by Dalal *et al.* (U.S. 2002/0065894).

Claims 19 and 20 are rejected under 35 U.S.C. §103(a) as unpatentable over Dalal in view of "Official Notice."

## VII.   ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

Claim 17

Appellant respectfully submits that claim 17 is not anticipated by Dalal for at least the following reasons. First, Dalal fails to disclose or suggest a central server that is responsive to an invitation message from an inviting user to exchange content with an inviting user, for providing a presence query, as recited in claim 17. Second, Dalal also fails to disclose or suggest that information relating to presence pertains to a spatial location of a registered user, as recited in claim 17. Therefore, Dalal fails to disclose or suggest all of the limitations recited in claim 17, and claim 17 is not anticipated by Dalal. *See In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (a claim is only anticipated if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference); *see also* MPEP § 2131.

Dalal does not teach or suggest a central server that is responsive to said presence information relating to said invited user registered at said presence server, for use in deciding said content is sent to the invited user, stored or refused, as recited in claim 17. The unified instant messaging processor (UIM) 10 of Dalal only provides presence state (global and local) for the buddies of a user to the user. It does not make a decision whether a content of the user should be directly forwarded to a buddy if the buddy wishes to be contacted, stored on the server for later delivery if the buddy wishes not to be disturbed, or refused. Especially, in Dalal, the UIM 10 cannot differentiate whether an invited user, although online, is busy or free, and hence handle the content differently. It can only differentiate whether the invited user is online or not.

In addition, Dalal fails to disclose or suggest information relating to presence pertains to a spatial location of the registered user, as recited in claim 17. Dalal discloses that a user may define global and local presence states. *See* Dalal paragraph [0006]. A presence state refers to

the user's status with respect to an instant messaging service, such as whether the user is online, offline or hidden. *See e.g.* Dalal paragraph [0003] (keeping track of the online availability of buddies is called presence management). However, the presence state, i.e. whether the user is online, does not pertain to a spatial location of the user, as recited in claim 17. Instead, the presence states merely inform the user's buddies if and how the user can be contacted through the instant messaging service, i.e. if the user is available. Therefore, presence information indicating that "John is on line" provides no information relating to the <u>spatial location</u> of John, since John may be at his computer terminal or using some sort of mobile communication device away from his computer terminal. *See* Dalal paragraph [0005].

According to the system discussed by Dalal the user may define a local presence state that specifies how and where a user wishes to be contacted. *See* Dalal paragraph [0007]. For instance, the user may be at remote locations away from the user's computer terminal. However, merely providing information whether a user is at the user's computer terminal or not is not a spatial location of the user, as recited in claim 17. The user of the term "spatial" indicates, as evidenced by the specification, information relating to or having the character of space that is founded on measurements of length or distance, i.e. geographic information. While Dalal may disclose that the user may be located at the user's computer terminal or located away from the terminal, the assertion that Dalal discloses the spatial location of a user is an unreasonably broad interpretation of this limitation of claim 17 which is inconsistent with the specification.

During patent prosecution an examiner must give claims their broadest reasonable interpretation consistent with the specification. *See* MPEP § 2111. However, the examiner is limited in how broad an interpretation can be given to a claim. The interpretation of a claim must be "reasonable." *In re Morris*, 44 USPQ2d 1023, 1028-29 (Fed. Cir. 1997) (question is whether the PTO's interpretation of the disputed claim language is "reasonable"). In addition, the interpretation must be "consistent with the specification." *In re Cortright*, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999). The interpretation of "spatial location" given to this phrase by the Office is unreasonable because it ignores the term "spatial" which modifies the term "location" to indicate that information pertaining to a specific geographic location of a registered user is provided, i.e. coordinates. *See e.g.* specification page 16, lines 5-7. The ordinary and customary meaning of the term "spatial" to one of skill in the art, as indicated by the specification, is

information relating to or having the character of space founded upon measurements of length or distance. *See* MPEP § 2111.1 (the ordinary and customary meaning of a claim term is the meaning the term would have to a person of ordinary skill in the art); *see also Phillips v. AWH Corp.*, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (the PTO determines the scope of the claims by giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art). Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). An interpretation of claim terms which ignores terms that modify other terms within the claim leads to an unreasonably broad interpretation of the claim. *See e.g. Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc.*, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (the correct meaning of a word or phrase is informed only by considering the surrounding text of the claim). Therefore, the phrase "spatial location" must be interpreted so that both words have meaning in the phrase, which does not occur if the Office equates the teachings of Dalal with the limitations recited in claim 17.

Instead, the phrase "spatial location" must be interpreted as representing the actual geographic location of the registered user. Dalal does not disclose or suggest providing the geographic location of the user, and even when the presence state indicates that the user is at the user's computer terminal the spatial location of the user is not provided with presence information. Therefore, for at least the reasons discussed above, Dalal does not disclose or suggest all of the limitations recited in claim 17, and claim 17 is not anticipated by Dalal.

## Claims 18 and 21

Claims 18 and 21 depend directly from independent claim 17, and are not disclosed or suggested by Dalal at least in view of their dependencies.

## Claims 17 and 19

Claims 17 and 19 ultimately depend from independent claim 17, and are not disclosed or suggested by Dalal at least in view of their dependencies.

## Conclusion

For the reasons discussed above, applicant respectfully submits that the rejections of the final Office Action have been shown to be inapplicable, and respectfully requests that the Board reverses the rejections to pending claims 17-21. If any additional fee is required for submission of this Appeal Brief, the Commissioner is hereby authorized to charge deposit account 23-0442.

**CLAIMS APPENDIX**

1.    (Withdrawn) Method for providing a presence service over an internet protocol network

comprising the steps of:

      receiving application layer signaling from users registering for said presence service,

      checking said signaling for spatial location information, and

      storing said spatial location information for use in providing said presence service.

2.    (Withdrawn) The method of claim 1, wherein said application layer signaling is

according to a session initiation protocol.

3.    (Withdrawn) The method of claim 2, wherein said spatial location information is received

as a spatial location payload.

4.    (Withdrawn) The method of claim 1, wherein said spatial location information is received

as a spatial location payload.

5.    (Withdrawn) The method of claim 1, further comprising the step of providing access to

said spatial location information to one or more location based services.

6.    (Withdrawn) The method of claim 5, wherein said access to said spatial location

information is provided to said one or more location based services without providing access to

associated user identity information.

7.    (Withdrawn) The method of claim 1, further comprising the step of using said spatial

location information in conjunction with a messaging service for providing messages to said

users.


8.    (Withdrawn) Method for using a presence service over an internet protocol (IP) network,

comprising the steps of:

        providing application layer signaling from a user registering spatial location information

relating to said user for use by a presence server in providing presence services, said user

        providing or receiving a message relating to use of said spatial location information by

said presence service using said application layer signaling.


9.    (Withdrawn) The method of claim 8, wherein said application layer signaling is

according to a session initiation protocol.


10.    (Withdrawn) The method of claim 9, wherein said spatial location information is

provided as a spatial location payload.


11.    (Withdrawn) The method of claim 8, wherein said spatial location information is

provided as a spatial location payload.

12.   (Withdrawn) The method of claim 8, wherein said step of providing or receiving a message relates to use of said spatial location information by said presence server in conjunction with a location based service.

13.   (Withdrawn) The method of claim 8, further comprising the step of utilizing a location based service in conjunction with said step of providing or receiving said message.

14.   (Withdrawn) The method of claim 8, wherein said step of providing application layer signaling includes the step of providing security for said spatial location information by encryption.

15.   (Withdrawn) The method of claim 8, wherein said step of providing application layer signaling includes the step of providing security for said spatial location information by including security information for use by said presence service in handling said spatial location information.

16.   (Withdrawn) The method of claim 8, further comprising the step of using said spatial location information in conjunction with a messaging service for said providing or receiving said message.

17.   (Previously presented) System, comprising:

a central server, responsive to an invitation message from an inviting user to exchange content with an invited user, for providing a presence query; and

a presence server, responsive to said presence query, for providing presence information relating to a registered user,

wherein said central server is responsive to said presence information relating to said invited user registered at said presence server, for use in deciding said content is sent to said invited user, stored or refused, wherein said presence query and invitation message are communicated according to an application layer control protocol and wherein said information relating to presence pertains to a spatial location of said registered user.

18. (Previously presented) The system of claim 17, wherein said central server is also responsive to said invitation message for providing a subscription query and wherein said system further comprises a messaging server, responsive to said subscription query, for providing notification information relating to a request from a subscribed user for notification of an event, and wherein said central server is responsive to said notification information for said subscribed user in deciding said content should be sent to said invited user, stored or refused.

19. (Previously presented) The apparatus of claim 18, wherein said application layer control protocol is a session initiation protocol (SIP).

20.    (Previously presented) The apparatus of claim 19, wherein said information relating to presence and pertaining to said spatial location of said registered user is communicated as a spatial location payload.

21.    (Previously presented) The apparatus of claim 17, wherein said information relating to presence and pertaining to said spatial location of said registered user is communicated as a spatial location payload.

22.    (Withdrawn) Method for using information relating to presence in conjunction with a messaging service, comprising the steps of:

registering a first plurality of users to a presence service in response to a corresponding plurality of register requests from the first plurality of users, wherein said register requests include information relating to a corresponding communications state of each of said first plurality of users;

subscribing a second plurality of users to an instant messaging service in response to a corresponding plurality of subscribe requests from said second plurality of users, wherein said subscribe requests include information relating to a corresponding request for notification of an event or set of events and wherein said first plurality of users includes users from said second plurality of users;

receiving an invitation message from a user registered to said presence service to exchange content with another registered user also subscribed to the instant messaging service; and

determining said communications state and said request for notification of said another registered user and deciding said content should be sent to said another registered user or stored by said instant messaging service depending on said communications state and said request for notification of said another registered user.

23.    (Withdrawn) The method of claim 22, wherein said register requests, subscribe requests, and invitation message conform to an application layer control protocol.

24.    (Withdrawn) The method of claim 23 wherein said application layer control protocol is a session initiation protocol (SIP).

25.    (Withdrawn) The method of claim 22, wherein said information relating to presence pertains to a spatial location of said user.

**EVIDENCE APPENDIX**

None.

## RELATED PROCEEDINGS APPENDIX

None.